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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,362	02/12/2001	John E. Cronin	ipCG-519	4218

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EXAMINER	
MOONEYHAM, JANICE A	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/781,362	CRONIN, JOHN E.	
	Examiner	Art Unit	
	Jan Mooneyham	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 February 2001 and 14 May 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the applicant's communication filed on February 12, 2001 and May 14, 2001. Claims 1-13 are currently pending in this application.

Priority

2. It is noted that this application appears to claim subject matter disclosed in prior Application Nos. 09/766,456, 09/781,361, 09/781,365 and 09/781,368. filed on January 19, 2001 and February 12, 2001.

If applicant desires priority under 35 U.S.C. 120 based upon a previously filed application, specific reference to the earlier filed application must be made in the instant application. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph unless it appears in an application data sheet. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. _____" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after

November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on June 12, 2001 is being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Examiner is unclear how to make or use the applicant's integrated software system. No structure has been identified.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant uses the abbreviations IP and IOD throughout the claim language without first identifying what it means.

The applicant states in the preamble that the invention is an integrated software system. Is the applicant's invention an actual system or just software? Furthermore, the applicant states that the invention is a system but does not provide any structure.

What does the applicant mean in Claim 1 by the term "provide output indicative of the stored data?"

In Claim 2, it is unclear what the wording "track opportunity areas in which inventions are desired is trying to define." What are opportunity areas?

Regarding claim 3, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). It is unclear how the applicant uses the words and phrases to search databases.

In Claim 3, it is unclear what applicant means by providing output which characterized inventive and research activity in the area.

What is an IP strategy tracking component?

What is an IP generation component?

What does the applicant mean by providing output suitable for use as input into an IP documentation component?

What is an IP documentation component?

What is invention documentation?

What is an invention review board? What does it mean by "tracking the results of an invention review board?"

The applicant uses the word "suitable" throughout the claims. For example, yielding an invention disclosure output suitable for use as an input in an IP review board tracking component. The Examiner is unclear what the applicant is defining or claiming since it is unclear when or what it entails to be suitable enough for use as an input.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The applicant has claimed a system and the method steps for using the system.

MPEP Section 2173.05(p) states as follows:

2173.05(p) Claim Directed to Product-By- Process or Product and Process

A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In Ex parte Lyell, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph.

Such claims should also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. Id. at 1551. 2173.05(q)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Rivette et al (US 2003/0046307) (hereinafter referred to as Rivette).

Referring to Claim 1:

Rivette discloses an integrated software system for intellectual property management programmed to perform the following functions:

accept input relating to one or more of the following areas: IP mapping-tracking; IP strategy-tracking; IP generation-tracking, IP documentation-tracking, IP review board-tracking; and IP application-tracking (Figs. 5, 59-60, page 2 [0025], Fig. 10 (Importing Data page 69 [1247-1248] Fig. 10 (1016)),

store the input in one or more data files (Fig. 3 (316), Fig. 5 (316), Fig. 10);

provide output indicative of the stored data (Fig. 10 (1018), Exporting Data page 69 [1249-1250]).

Referring to Claim 2:

Rivette discloses. a system comprising an IP mapping-tracking component programmed to track opportunity areas in which inventions are desired ((Fig. 10 (1002)).

Referring to Claim 3:

Rivette discloses a system comprising an IP mapping-tracking component programmed to utilize input words and phrases descriptive of a market area or technology areas (page 16 [0395], Fig. 139 (614));

search databases, such as patent and literature databases (page 16 [0395] thru page 20 [0453]); and

provide an output which characterizes inventive and research activity in the area Fig. 139).

Referring to Claim 4:

Rivette discloses a system of claim 1 comprising an IP strategy tracking component programmed to track (Page 58 [1092-1093, page 61 [1132-1133])
invention strategy.

Referring to Claim 5:

Rivette discloses a system comprising an IP strategy-tracking component, which: (a) uses product and technology output from all IP mapping method as input (page 2 [0020]), and (b) produces output comprising problems and elements for use as input in an IP generation component. (page 8 [0268])

Referring to Claim 6:

Rivette discloses a system comprising an IP generation-tracking component programmed to track creation of new inventions (page 61 [1132-1137]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 7-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette as applied to claim 1 above, and further in view of Hunter et al (US 6,298,327) (hereinafter referred to as Hunter).

Referring to Claim 7:

Rivette does not explicitly disclose a system comprising an IP generation-tracking component programmed to provide output suitable for use as input into an IP documentation component.

However, Hunter discloses disclose a system comprising an IP generation-tracking component programmed to provide output suitable for use as input into an IP documentation component (Col. 3, line 53 thru col. 4, line 32).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into Rivette the teachings of Hunter so that inventors can adequately disclose the characteristics of their inventions to their technology manager and research sponsor and the technology manager and/or the research sponsor can decide whether to invest in protecting the invention.

Referring to Claim 8:

Hunger discloses a system comprising an IP documentation-tracking component programmed to track invention documentation (col. 3, line 53 thru col. 4, line 20).

Referring to Claim 9:

Hunter discloses a system comprising an IP review board-tracking component programmed to track the schedule and results of an invention review board (Col. 2, lines 43-65, col. 8, lines 12-40).

Referring to Claim 10:

Hunter discloses.a system comprising an IP application filing-tracking component programmed to track patent application filing data and optionally tracks patent prosecution data (col. 2, line 66 thru col. 3, line 29).

Referring to Claim 11:

Hunter discloses a system comprising an IP application filing-tracking component programmed to:

(a) capture output from an IP generation method component (col. 3, line 53 thru col. 4, line 20); and

(b) yield invention disclosure output suitable for use as input in an IP review board-tracking component of the invention (col. 4, lines 21-32, col. 8, lines 12-18).

Referring to Claim 12:

Hunter discloses a system comprising an IP review board-tracking component programmed to accept input assigning a disposition to an invention tracked by the system (col. 8, lines 12-18).

Referring to Claim 13:

Hunter and Rivette disclose a system wherein the input includes data selected from the group consisting of:

invention identification number, technology area; product area; company name; company site; invention title, inventor; manager of inventor; bar date; comments; technology name; product name, problem; elements/methods; IP scanning session name; IP scanning session date; IODTM session name; IOD session date; pre-existing invention; client tracking number, company disclosure number; disclosure writer; IP manager; additional inventorship information; inventor

interview date; idea withdrawal date; first draft, completion date; inventor's draft; review date; disclosure submission date; invention review date; invention review attorney; disclosure rating', search sent date; search received date; attorney review complete date; final disposition; patent docket number, patent docket creation date; docket attorney; docket delivery date; application filing date; notice of allowance date; patent issued date; date of expiration of patent term; docket closure date; and license value (Hunter -col. 8, line 50 thru col. 30, line 52) (Rivette (Fig. 12H-12I, Figs. 68-69, page 29 [0178[)

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bouty discloses that the key to fostering innovation is exchanges between scientists across organization boundaries is essential.

Kanevsky discloses a web based secured method and system for collaborative invention creation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jm

DENNIS RUHL
PRIMARY EXAMINER